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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,378	06/02/2000	JEAN-YVES SANCHEZ	032013-024	7406

7590

04/04/2002

E JOSEPH GESS  
BURNS DOANE SWECKER & MATHIS  
PO BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER
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ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 04/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

1-D-7

# Office Action Summary

Application No.

09/508,378

Applicant(s)

SANCHEZ ET AL.

Examiner

Tatyana Zalukaeva

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-23, and 29 drawn to a polymer of acrylonitrile and process of its making.
  - II. Claims 24-27, 28, 30-32, 35 and 36 drawn to a block copolymer of acrylonitrile and method of its making.
2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Where the group of inventions is claimed in one and the same international application, the requirement for unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "**special technical features**" shall mean those technical features that define a contribution which each of the claimed inventions considered as a whole , **makes over the prior art**. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, although they share the special technical feature, this special technical feature does not define a contribution over the prior art for the following reasons: Claim 1 is either obvious or anticipated by any one of the following JP 62219469, JP 19960173867, EP 0 798 791 each individually.

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Accordingly, the special technical feature linking the inventions, providing a **block** copolymer of acrylonitrile with listed comonomers does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore the restriction is appropriate

Applicants are advised that if the polymer different than **block copolymer of acrylonitrile and ethylene oxide is elected**, claims 31 and 31 would be further restricted as drawn to a method of making a copolymer **other than** that claimed as a process.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- a) one of four possible polymers of claim 1; and to indicate if the polymer is a bipolymer, or terpolymer;
- b) a single disclosed specie for a comonomer of claim 2, which would encompass an election for the comonomers of either claim 5 or claim 14
- b) a **single disclosed specie** for an acrylic or methacrylic comonomer, presented as formula  $\text{CHX}=\text{CZ}-\text{CO}-\text{V}-\text{Y}$  of claim 5, if acrylic comonomer is elected
- c) if a terpolymer is elected, then a single disclosed copolymer should be indicated between claims 12 and 13:

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- d) a single disclosed specie (naming the specie) of comonomers of claim 14, if such monomers are elected for claim 2.
- e) a single disclosed specie for comonomers of claim 20 or claim 23 , if such groups of comonomers is elected for claim 2;
- f) a diblock or triblock copolymer, as per claims 25 or 26;
- g) a solvent, as per claim 26;
- h) a single disclosed specie for anionic initiation type, as per claims 30 and 31 and for termination type

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. **The reply must also identify the claims readable on the elected species, including any claims subsequently added.**

Applicant is required under 35 U.S.C. § 121 to elect a single ultimate disclosed specie for each of the above genera for prosecution on the merits to which claims shall be restricted if no generic claim is finally held allowable. Where specific species are not identified in the claims , Applicant should elect a **specific specie from the Specification. An alternative method of election is to identify an Example which collectively exemplifies the elected species.**

An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. The claims are deemed to correspond to the species listed above in the following manner:

1,2,5, 12, 13,14, 20, 23, 25, 26, 30, 31.

The following claim(s) are generic: 1,2,5, 12, 13,14, 20, 23, 25, 26, 30, 31.

5. Due to complexity of election/restriction requirement , no attempt was made to initiate a telephone election.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (703) 308-8819. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

  
TZ  
April 3, 2002

Tatyana Zalukaeva  
Examiner  
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